REMARKS

This amendment is being filed in response to the Office Action mailed September 3, 2010 ("the Action"). Reconsideration of the application is respectfully requested. Claims 1-16 were previously cancelled. Claims 17-39 are pending and stand rejected. Editorial amendments have been made to the claims. These amendments are fully supported by the specification; no new matter is added. Reconsideration of the claims in view of the foregoing amendments and the following remarks is respectfully requested.

Claim Rejections Under 35 U.S.C. § 101

Claims 32-38 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Specifically, the Action alleges that the "computer-accessible storage medium" language of claims 32-38 "can be interpreted to include non-statutory media such as a wireless signal or carrier wave." [Action, at § 4, pages 2 and 3.] While it is not necessarily agreed that the claims may be interpreted in this manner, in the interest of expediting prosecution, claim 32 has been amended to recite "a tangible, non-transitory computer-accessible storage medium." It is respectfully submitted that claim 32, as presented herein, satisfies the requirements of 35 U.S.C. § 101. Furthermore, claims 33-38, which depend from claim 32 and repeat its recitations, satisfy the requirements of 35 U.S.C. § 101 as well. It is respectfully requested that the rejection of claims 32-38 under 35 U.S.C. § 101 be withdrawn and that the claims be allowed.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 17-21, 24-29, and 32-36

Claims 17-21, 24-29, and 32-36 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,933,146 to Wrigley (hereinafter

"Wrigley") in view of U.S. Patent App. Pub. No. 2006/0066607 to Schmittler et al. (hereinafter "Schmittler"). Claims 17, 24, and 32 are independent. In the rejection, the Action acknowledges that various recitations of independent claims 17, 24, and 32 are not taught by Wrigley. [*See*, Action, at § 7, page 4; § 12, page 6; and § 18, page 9.] However, the Action allegedly finds relevant disclosure in Schmittler. For example, the Action allegedly finds disclosure for "storing, by the computing device, the object of intersection in a list of objects that have been intersected by the ray" in Schmittler. [Action, at § 7, page 4.] The applicability of Schmittler as a proper reference in rejecting claims of the instant application is respectfully traversed.

Schmittler is a publication, dated March 30, 2006, of U.S. Pat. App. No. 10/526,055, filed Sept. 19, 2005. U.S. Pat. App. No. 10/526,055 is the U.S. national stage of PCT application PCT/DE2003/002801, which has an international filing date of August 20, 2003. PCT application PCT/DE2003/002801 was published, in German, on March 11, 2004 and lists Universitat des Saarlandes as an applicant. PCT application PCT/DE2003/002801 claims priority to German application 10239672.8, which was filed in Germany on August 26, 2002 and published on March 11, 2004. German application 10239672.8 was granted on March 15, 2005.

The instant application, U.S. Pat. App. No. 10/589,794, is the U.S. national stage of PCT application PCT/DE2005/000266, which has an international filing date of February 16, 2005. PCT/DE2005/000266 also lists Universitat des Saarlandes as an applicant. PCT application PCT/DE2005/000266 claims priority to German application 102004007835.1, which was filed in Germany on February 17, 2004.

It is initially submitted that neither Schmittler, its parent PCT application PCT/DE2003/002801, nor its grandparent German application 10239672.8, may be applied in a rejection against the instant application under 35 U.S.C. §§ 102(a), (b), (d), or (e).

With respect to § 102(a), it is respectfully noted that the earliest publications of the material in Schmittler were the publications of PCT/DE2003/002801 and German application 10239672.8 on March 11, 2004. These publications were made *after* the

instant application's priority date of February 17, 2004. As such, the Action has not satisfied the requirement under § 102(a) that the subject matter of the instant application was "described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent." [35 U.S.C. § 102(a).] Schmittler therefore cannot be applied against the instant application under 35 U.S.C. § 102(a)

With respect to § 102(b), it is respectfully noted that the international filing date of the instant application's parent PCT application is February 16, 2005. As such, the instant application's effective U.S. filing date is also February 16, 2005. [*See*, MPEP 706.02.VI.] The U.S. filing date is therefore *less than one year* from the March 11, 2004 date of publication of the Schmittler parent PCT and grandparent German applications. As such, the Action has not satisfied the requirement under § 102(b) that the subject matter of the instant application was:

> patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

[35 U.S.C. § 102(b).] Schmittler therefore cannot be applied against the instant application under 35 U.S.C. § 102(b)

With respect to § 102(d), it is respectfully noted that German application 10239672.8 was granted on March 15, 2005, which is *after* the February 16, 2005 effective U.S. filing date of the instant application's. As such, the Action has not satisfied the requirement under § 102(d) that the subject matter of the instant application was "first patented or caused to be patented . . . in a foreign country prior to the date of the application for patent in this country . . . ." [35 U.S.C. § 102(d).] Schmittler therefore cannot be applied against the instant application under 35 U.S.C. § 102(d).

With respect to § 102(e), it is respectfully noted that Schmittler's parent application, PCT application PCT/DE2003/002801, was published in German, and not in English. As such, Schmittler may only be potentially applied under 35 U.S.C. § 102(e) as of its U.S. filing date of Sept. 19, 2005. [*See*, MPEP 706.02(f)(1)(I)(C)(2).] Schmittler's § 102(e) date of Sept. 19, 2005 is therefore *after* both the instant application's priority date of February 17, 2004 and its effective U.S. filing date of

February 16, 2005. As such, the Action has not satisfied the requirement under § 102(e) that the subject matter of the instant application was "described in . . . an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent . . . ." [35 U.S.C. § 102(e)(1).] Schmittler therefore cannot be applied against the instant application under 35 U.S.C. § 102(e).

It is respectfully submitted that the Action has not demonstrated that Schmittler can be applied against the instant application under 35 U.S.C. §§ 102(a), (b), (d), or (e). Further, no evidence is provided in the Action that Schmittler may be applied under 35 U.S.C. §§ 102(f) or (g).

As Schmittler cannot be applied against the instant application under 35 U.S.C. §102, it is respectfully submitted Schmittler may not be applied against the instant application under 35 U.S.C. §103(a), for the reasons set forth below.

It is respectfully submitted that 35 U.S.C. § 103(c) prevents the Action from applying Schmittler against the instant application under 35 U.S.C. § 103(a). 35 U.S.C. § 103(c)(1) states:

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section *where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.*

[35 U.S.C. § 103(c)(1); emphasis added.] For at least the reasons discussed above, Schmittler may not be applied against the instant application under 35 U.S.C. §§ 102(a), 102(b), or 102(d). As such, Schmitler may, at most, only be applied as a reference against the instant application under U.S.C. §§ 102(e), 102(f), or 102(g). However, as noted above, PCT/DE2003/002801 and PCT/DE2005/000266 both list Universitat des Saarlandes as an applicant. It is respectfully submitted, therefore, that both applications were "owned by the same person or subject to an obligation of assignment to the same person," as quoted above. By the requirements of 35 U.S.C. § 103(c)(1), Schmittler may therefore not qualify as a reference against the instant application under 35 U.S.C. § 103(a).

For at least these reasons, Schmittler may not be applied in a rejection against the instant application under 35 U.S.C. § 103(a). As discussed above, the Action acknowledged that recitations of each of the independent claims were not taught by Wrigley, and instead relied on Schmittler to disclose the recitations. With Schmittler's inapplicability as a proper reference to use to support a rejection, the Action has failed to show that each and every element of the independent claims is taught or suggested by applicable references. It is therefore submitted that the Action fails to make a *prima facie* case of obviousness of independent claims 17, 24, and 32. The rejection of independent claims 17, 24, and 32 should therefore be allowable. Further, claims 18-21, 25-29, and 33-36 depend from claims 17, 24, and 32 and repeat their recitations. As such, claims 18-21, 25-29, and 33-36 should likewise be allowable, and also further allowable in view of the additional recitations contained therein. It is respectfully requested that the rejection of claims 17-21, 24-29, and 32-36 under 35 U.S.C. § 102(e) be withdrawn and that the claims be allowed.

Claims 22, 23, 37, and 38

Claims 22, 23, 37, and 38 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wrigley in view of Schmittler and further in view of U.S. Patent No. 6,597,359 to Lathrop (hereinafter "Lathrop"). Claims 22, 23, 37 and 38 depend from independent claims 17 and 32, respectively. For at least the reasons discussed above, Schmittler may not be applied in a rejection against the instant application under 35 U.S.C. § 103(a). Further, relevant disclosure is not found in Lathrop to address the deficiency of the rejection. It is therefore submitted that claims 22, 23, 37, and 38 are allowable over the cited references. It is respectfully requested that the rejection of claims 22, 23, 37, and 38 under 35 U.S.C. § 103(a) be withdrawn and that claims 22, 23, 37, and 38 be allowed.

Claim 30

Claim 30 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wrigley in view of Schmittler and further in view of U.S. Patent App. Pub. No. 2004/0233222 to Lee et al. (hereinafter "Lee"). Claim 30 depends from independent claim 24. For at least the reasons discussed above, Schmittler may not be applied in a rejection against the instant application under 35 U.S.C. § 103(a). Further, relevant disclosure is not found in Lee to address the deficiency of the rejection. It is therefore submitted that claim 30 is allowable over the cited references. It is respectfully requested that the rejection of claim 30 under 35 U.S.C. § 103(a) be withdrawn and that claim 30 be allowed.

Claims 31 and 39

Claims 31 and 39 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wrigley in view of Schmittler, further in view of Lee, and further in view of Lathrop.

Claim 31 depends from independent claim 24. For at least the reasons discussed above, Schmittler may not be applied in a rejection against the instant application under 35 U.S.C. § 103(a). Further, relevant disclosure is not found in Lee or Lathrop to address the deficiency of the rejection. It is therefore submitted that claim 31 is allowable over the cited references. It is respectfully requested that the rejection of claim 31 under 35 U.S.C. § 103(a) be withdrawn and that claim 31 be allowed.

Claim 39 is independent. In the rejection, the Action acknowledges that various recitations of independent claims 39 are not taught by Wrigley, but finds relevant disclosure in Schmittler. [*See*, Action, at § 32, page 19.] For at least the reasons discussed above, Schmittler may not be applied in a rejection against the instant application under 35 U.S.C. § 103(a). Further, relevant disclosure is not found in Lee or Lathrop to address the deficiency of the rejection. It is therefore submitted that claim 39 is allowable over the cited references. It is respectfully requested that the rejection of claim 39 under 35 U.S.C. § 103(a) be withdrawn and that claim 39 be allowed.

CONCLUSION

In view of the foregoing amendments and remarks, it is believed the applicable rejections have been overcome and all claims remaining in the application are presently in condition for allowance. Accordingly, favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to telephone the undersigned representative at (206) 407-1577 if the Examiner believes that an interview might be useful for any reason.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 CFR 1.136(a). If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

Date: December 3, 2010

by: /Ryan C. Fox/
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